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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,949	12/27/2000	Gregory C. Flickinger	T721-13	6470

27832 7590 07/23/2004
EXPANSE NETWORKS, INC.
6206 KELLERS CHURCH ROAD
PIPERSVILLE, PA 18947

EXAMINER

SHELTON, BRIAN K

ART UNIT PAPER NUMBER

2611

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/748,949	Applicant(s) FLICKINGER ET AL.	
	Examiner Brian Shelton	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-6 and 9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to the Application filed 27 December 2000.
2. The Application has been examined. **Original claims 1-24** are pending.

The objections and rejections cited are as stated below:

Claim Objections

3. **Claim 14** is objected to because of the following informalities: In claim 14 at line 2, "receiving the metadata" should be changed to --receiving metadata-- because the element is not disclosed in parent claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 17** is rejected under 35 U.S.C. 112, 2nd paragraph as being indefinite.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d

1029, 1033 (Fed. Cir. 1999). The term “splice window” in claim 17 at line 2-3 is used by the claim to define when an advertisement may be stored, while the accepted meaning of a “splice window” refers to the insertion of a first programming content into a second programming content at a specified time (i.e., inserting an advertisement into a broadcast feed during a local content space). The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-2, 5-6, 12, 14-22 and 24** are rejected under 35 U.S.C. 102(e) as being anticipated by Picco et al. (Picco), U.S. Patent No. 6,029,045.

Regarding **claim 1**, Picco discloses in a television network environment, a method for selectively storing targeted advertisements at a set-top box (Fig. 9; col. 6, lines 17-29), the method comprising:

- a) receiving an advertisement channel having a plurality of advertisements (Fig. 9, step 232; col. 9, lines 31-37 [describing receiving ads from separate (e.g., advertisement) channel]; see col. 13, lines 36-40);
- b) determining if an advertisement is appropriate for the set-top box (Fig. 9, step 234; col. 13, lines 45-52; see col. 7, line 56 – col. 8, line 6 [describing distribution variable that indicates whether advertisement is appropriate for all set-tops or those matching a specific profile value]); and
- c) retaining the advertisement if it is found to be appropriate (Fig. 9, step 238, col. 13, lines 52-55).

As for **claim 2**, Picco discloses the determining is performed in real-time or near real-time (col. 13, lines 48-55 [real time determination whether content satisfies profile and subsequent storage or discard]).

As for **claim 5**, Picco discloses the determining is based on one or more pre-determined parameters (col. 13, lines 42-46 [content profile data]; see also col. 7, line 55 – col. 8, line 6).

As for **claim 6**, Picco discloses said receiving includes receiving one or more targeted advertisements via the advertisement channel (col. 9, lines 31-37).

As for **claim 12**, Picco discloses said receiving includes receiving metadata (content profile data; see col. 13, lines 42-46) via the advertisement channel (e.g., completely separate channel) (col. 9, lines 31-37).

As for **claim 14**, Picco discloses said receiving includes receiving metadata (content profile data; see col. 13, lines 42-46) and splice timing information (e.g., utilization directives including view interval and time of day content may be viewed; col. 6, line 61 – col. 7, line 2) col. via the advertisement channel (e.g., completely separate channel) (col. 9, lines 31-37).

As for **claim 15**, Picco discloses the metadata and splice timing (content profile data and utilization directives; see col. 13, lines 42-46 and col. 7, line 55 – col. 8, line 6) information is encoded as a data service (i.e., transport stream) on the advertisement channel (col. 11, lines 35-37 [locally extracting control data (i.e., content profile data and utilization directives) from MPTS]; see col. 8, lines 40-55, describing encoding control information in MPTS).

As for **claim 16**, Picco discloses decoding the data service and identifying the timing of the advertisement from the splice timing

information (col. 6, line 61 –col. 7, line 2 [utilization directives including timing information]; (col. 11, lines 35-37 [locally extracting control data (i.e., content profile data and utilization directives) from MPTS])).

As for **claim 17**, Picco discloses storing the advertisement during one or more splice windows identified by splice timing information (the utilization directives comprising “insert channel list” or “a time of day local content may be viewed” described at col. 6, line 61 – col. 7, line 2, inherently includes one or more time periods during which the programs are stored prior to the actual insertion or viewing, col. 13, lines 48-58).

Regarding **claim 18**, Picco discloses in a television network environment, an advertisement management system (Fig. 4) comprising:

- a) an advertisement channel generator (Fig. 4, combiner 142) for receiving one or more advertisements and their corresponding metadata information (local content (e.g., ads) and associated content profile (col. 6, line 61 –col. 7, line 2) from an advertisement server (Fig. 4, database 146) and generating an advertisement channel comprising the advertisements and the metadata information (col. 6, lines 46-56; see col. 9, lines 31-37, describing ad channel); and

- b) a set-top box (Fig. 8) for receiving the advertisement channel and retrieving the advertisements and the metadata information (col. 12, line 59 – col. 13, line 23).

As for **claim 19**, Picco discloses the set-top box comprises a decoder (Fig. 8, Decoder **202** and TS **204**) for decoding the advertisement channel to differentiate between the metadata information and the advertisements (col. 13, lines 3-16).

As for **claim 20**, Picco discloses the set-top box further comprises a processor (Fig. 8, CPU **188** and TS Processor **204**) for decoding the metadata information to determine one or more corresponding instructions (col. 13, lines 3-16).

As for **claim 21**, Picco discloses the processor further associates the instructions to the received advertisements to select one or more appropriate advertisements (Fig. 10, col. 13, lines 67 – col. 14, line 13).

As for **claim 22**, Picco discloses the set-top box further comprises a memory for storing the selected advertisements (Fig. 8, disk **186**; see col. 11, lines 35-40).

As for **claim 24**, Picco discloses an advertisement sequencer/multiplexer (Fig. 4, Mux **140**) for multiplexing the advertisements on the advertisement channel (col. 6, lines 46-50).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al (Picco), U.S. Patent No. 6,029,045 in view of Guyot et al. (Guyot), U.S. Patent No. 6,119,098.

Regarding **claim 3**, although Picco discloses storing the plurality of advertisements from the ad channel on a hard drive, Picco fails to disclose the storing prior to determining.

However, Guyot, in an analogous art, teaches storing advertisements on a hard drive prior to determining if the advertisement is appropriate (col. 7, lines 12-25) for the benefit of displaying received advertisements on a display device until a specified expiration date.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the determination of Picco to incorporate storing the advertisements prior to determining, as

taught by Guyot, for the benefit of displaying received advertisements on a display device until a specified expiration date in a method for storing targeted advertisements.

10. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al (Picco), U.S. Patent No. 6,029,045 in view of Guyot et al. (Guyot), U.S. Patent No. 6,119,098, as applied to claim 3, above, further in view of Naruto et al. (Naruto), U.S. Patent No. 6,724,974.

Regarding **claim 4**, although Guyot teaches removing expired ads (i.e., ads which are no longer appropriate) (see col. 7, lines 12-25) from an ad queue, Guyot fails to specifically disclose deleting the ads.

However, Naruto, in an analogous art, teaches deleting outdated (e.g., expired) media files from a hard drive (col. 4, lines 7-15) for the benefit of reducing a user's burden of data managing operations (col. 4, lines 51-53).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the data storage of Picco in view of Guyot to incorporate deleting the advertisement from the hard drive if the advertisement is found to be inappropriate, as taught by Naruto, for the benefit of reducing a user's burden of data managing operations in a method for storing targeted advertisements.

11. **Claims 7-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (Picco), U.S. Patent No. 6,029,045 in view of Hendricks et al. (Hendricks), U.S. Patent No. 6,738,978.

Regarding **claim 7**, Picco discloses assigning each advertisement within the ad channel a unique ad id (col. 6, line 61 – col. 7, line 2 [unique content identifier code]) and assigning the set-top box to one or more groups (col. 7, line 56 – col. 8, line 6). Picco fails to disclose forming Ad ID and STB-group id tables, and creating a master STB-AD_ID table, as claimed.

However, Hendricks, in an analogous art, teaches utilizing tables (e.g., databases) for advertisement targeting operations, including Ad ID (Fig. 12, Advertisements File of Advertisement Library database 322; col. 32, lines 48-55) and set top ID database (Fig. 20, col. 37, lines 49-51 and col. 38, lines 5-9 (i.e., tables) and further utilizing (e.g., joining) the Ad database and set top group information to target commercial insertion (col. 32, lines 56-65) for the benefit of optimizing the organization and analysis of ad selection data.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Picco to incorporate forming an ad ID group table, forming an STB-group table, and joining the ad ID and the STB group table to create a master STB-AD ID table, as taught by Hendricks, for the benefit of optimizing the

organization and analysis of ad selection data in a method for selectively storing targeted advertisements.

The limitation of **claim 8** is met by the teachings of Picco in view of Hendricks, as discussed above relative to claim 7. Specifically, Hendricks discloses determination based on a set-top and advertisement (e.g., STB-AD_ID) table (col. 32, lines 56-65, describing advertisement scheduling database).

As for **claims 9-11**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined systems of Picco in view of Hendricks to incorporate typical database field structures, as recited in claims 9-11, which provide the well-known benefit of for manipulating (i.e., sorting, entering data, identifying, comparing, and searching) and managing data for targeted advertisements in an method for selectively storing advertisements.

12. **Claims 13 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al (Picco), U.S. Patent No, 6,029,045 in view of Nemirofsky et al. (Nemirofsky), U.S. Patent No. 5,761,601.

As for **claim 13**, Picco is relied upon as discussed above in claim 12, but fails to disclose the metadata transmitted in a vertical blanking interval, as claimed.

However, Nemirofsky, in an analogous art, teaches transmitting control data (i.e., metadata) in a vertical blanking interval (col. 9, lines 3-20) for the benefit of transmitting control data within analog programming signals (col. 3, lines 34-36).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the metadata of Picco to incorporate the metadata is transmitted in a vertical blanking interval, as taught by Nemorofsky, for the benefit of transmitting control data within analog programming signals in a system for storing targeted advertisements.

As for **claim 23**, Picco is relied upon as discussed above relative to claim 18, but fails to disclose the vertical blanking interval encoder, as claimed.

However, Nemirofsky, in an analogous art, teaches an data insertion unit (i.e., ad channel generator) comprising a vertical blanking interval encoder for encoding metadata information (e.g., control data) (col. 7, lines 1-3; col. 9, lines 3-20) for the benefit of transmitting control data within analog programming signals (col. 3, lines 34-36).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the advertisement channel generator of Picco to incorporate a vertical blanking interval encoder for encoding metadata information on an advertisement channel, as taught by Nemirofsky, for the benefit of transmitting control data within analog programming signals in an advertisement management system.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Zigmond et al. (Zigmond), U.S. Patent No. 6,698,020 discloses a system for selecting and inserting advertisements wherein the advertisements are selectively stored on a client device and the device interrupts a programming feed to insert a selected advertisement in response to detecting a triggering event (abstract, Figs. 5 and 6; col. 10, line 16 – col. 17, line 49).

14. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Shelton whose telephone number is (703) 305-8714. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Shelton
Examiner
Art Unit 2611

BS


CHRIS GRANT
PRIMARY EXAMINER